



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,484	02/02/2001	Alan J. Ying	4722-001	1879

20792 7590 02/25/2005

MYERS BIGEL SIBLEY & SAJOVEC
PO BOX 37428
RALEIGH, NC 27627

EXAMINER

NAJARIAN, LENA

ART UNIT	PAPER NUMBER
----------	--------------

3626

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/776,484

Applicant(s)

YING ET AL.

Examiner

Lena Najarian

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20010510; 20030408</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 9-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claims 9 and 15-16 recite the limitations for which there is no antecedent basis in the claims. In particular, the following passage lacks or has vague antecedent basis:

(i) "the previously provided mobile terminals": claim 9, lines 4-5

claim 15, lines 1-2

claim 16, lines 1-2.

(ii) Claims 10-14 incorporate the deficiencies of claim 9, through dependency, and are also rejected.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 3626

5. Claims 1-3, 5, 7-9, 15-19, 21-27, and 30-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Besette (US 2001/0016822 A1).

(A) Referring to claim 1, Besette discloses a method of presenting medical records for use by a medical provider, comprising:

extracting pre-existing medical records from a database (para. 26 of Besette; the Examiner interprets "physician" to be a form of "medical provider");

formatting said medical records for presentation on a mobile terminal; and

delivering at least one of said formatted medical records to a mobile terminal possessed by a medical provider (para. 99 of Besette; the Examiner interprets "PCS" to be a form of "mobile terminal" and "certain amount of information can be displayed" to be a form of "formatting").

(B) Referring to claim 2, Besette discloses wherein formatting said medical records for presentation on a mobile terminal comprises providing ergonomic actuators within said medical records to move between different screens containing different information (para. 99 of Besette; the Examiner interprets "user-friendly interface" to be a form of "ergonomic actuators").

(C) Referring to claim 3, Besette discloses wherein delivering at least one of said formatted medical records to the mobile terminal possessed by the medical provider comprises delivering at least one of said medical records to a wireless telephone (para. 99 of Besette; the Examiner interprets "cellular phone" to be a form of "wireless telephone").

Art Unit: 3626

(D) Referring to claim 5, Besette discloses wherein extracting pre-existing medical records from a database comprises extracting pre-existing medical records from a hospital database (para. 27, lines 1-5 of Besette).

(E) Referring to claim 7, Besette discloses further comprising accepting input from the mobile terminal to update said at least one medical record (para. 67, lines 17-19 of Besette).

(F) Referring to claim 8, Besette discloses further comprising updating through the mobile terminal at least one medical record (para. 101 of Besette; the Examiner interprets "cellular phone" to be a form of "mobile terminal").

(G) Referring to claim 9, Besette discloses a method of presenting information to medical providers comprising:

- providing each of a plurality of medical providers with a mobile terminal;
- establishing a format for the information to be presented;
- delivering the information to at least one of the previously provided mobile terminals (para. 18, para. 26, and para. 99 of Besette).

(H) Referring to claim 15, Besette discloses wherein delivering the information to at least one of the previously provided mobile terminals comprises delivering the information to the mobile terminals through a docking station (para. 68 of Besette; the Examiner interprets "communicating directly with the peripheral device(s)" to be a form of "docking station").

Art Unit: 3626

(I) Referring to claim 16, Besette discloses wherein delivering the information to at least one of the previously provided mobile terminals comprises delivering the information to the mobile terminals wirelessly (para. 95 and para. 102 of Besette).

(J) Referring to claim 17, Besette discloses a method of compiling a database of medical information, comprising:

- accessing a pre-existing database of medical records (para. 25, lines 1-3 of Besette);

- extracting therefrom said medical records (para. 26 of Besette);

- reformatting said medical records for delivery to mobile terminals (para. 99, lines 8-15 of Besette); and

- storing said reformatted medical records in a computer memory (para. 32 and para. 33 of Besette).

(K) Referring to claim 18, Besette discloses wherein reformatting said medical records for delivery to mobile terminals comprises providing ergonomic buttons to switch between different classes of information in the medical record (para. 99 of Besette; the Examiner interprets "user-friendly interface" to be a form of "ergonomic buttons").

(L) Referring to claim 19, Besette discloses further comprising updating said medical records with information provided by medical providers from mobile terminals (para. 101 of Besette).

(M) Referring to claim 21, Besette discloses further including accessing reference material corresponding to the information and displaying the reference material (para. 80, lines 1-6 of Besette).

Art Unit: 3626

(N) Referring to claim 22, Besette discloses further comprising temporarily storing the medical records in memory associated with the mobile terminals (para. 101, lines 1-5 of Besette).

(O) Referring to claim 23, Besette discloses a system for delivering information to medical providers, comprising:

- a computer for storing medical records;

- a plurality of mobile terminals; and

- means for providing said medical records to at least one of said plurality of mobile terminals (Fig. 1 and para. 99 of Besette).

(P) Referring to claim 24, Besette discloses a mobile terminal comprising:

- a controller;

- a display operatively connected to said controller; and

- means for communicating with a database comprising medical records;

said medical records viewable on said display, said display comprising one or more buttons for switching between different classes of information in said medical records (para. 99 of Besette).

(Q) Referring to claim 25, Besette discloses a method of providing medical records to a doctor treating patients within a medical facility, said method comprising (para. 27 of Besette; the Examiner interprets "hospital" to be a form of "medical facility"):

- providing the doctor with a mobile terminal having a memory for storing medical information regarding at least one patient (para. 29 of Besette; the Examiner interprets "PCS" to be a form of "mobile terminal");

providing a main database comprising the medical information regarding at least one patient (para. 29 of Besette; the Examiner interprets "NDSMR database" to be a form of "main database");

sending the medical information regarding at least one patient from the main database to the mobile terminal (para. 95 of Besette);

receiving updated information from the doctor at the mobile terminal; and

maintaining the main database updated by transferring said updated information from said mobile terminal to said main database (para. 101 of Besette).

(R) Referring to claim 26, Besette discloses wherein maintaining the main database updated by transferring said updated information from said mobile terminal to said main database comprises maintaining the main database updated by transferring said updated information from said mobile terminal to said main database through a docking station (para. 68 and para. 101 of Besette; the Examiner interprets "communicating directly with the peripheral device(s)" to be a form of "docking station").

(S) Referring to claim 27, Besette discloses wherein maintaining the main database updated by transferring said updated information from said mobile terminal to said main database comprises maintaining the main database updated by transferring said updated information from said mobile terminal to said main database through a wireless area network (para. 101 and para. 102 of Besette).

(T) Referring to claim 30, Besette discloses further including providing reference information to the mobile terminal upon receiving a request (para. 80 of Besette).

(U) Referring to claim 31, Besette discloses a method of providing medical records to a doctor treating patients within a medical facility, said method comprising (para. 27 of Besette; the Examiner interprets "hospital" to be a form of "medical facility"):

providing the doctor with a mobile terminal having a memory for storing medical information regarding at least one patient (para. 29 of Besette; the Examiner interprets "PCS" to be a form of "mobile terminal");

providing a main database comprising the medical information regarding at least one patient (para. 29 of Besette; the Examiner interprets "NDSMR database" to be a form of "main database");

receiving updated information from the doctor at the mobile terminal; and

updating the main database by incorporating the updated information into the database (para. 101 of Besette).

(V) Referring to claim 32, Besette discloses a method of maintaining records at a medical facility, said method comprising the steps of (para. 27 of Besette):

providing mobile terminals to a plurality of physicians (para. 29 of Besette);

maintaining a database containing a medical status of a plurality of patients;

sending information regarding at least one patient to at least one of the mobile terminals (para. 95 of Besette);

receiving treatment updates from at least one of the mobile terminals; and

updating the database to include the treatment updates (para. 85 and para. 101 of Besette).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Besette (US 2001/0016822 A1) in view of Dahlin et al. (US 2004/0078215 A1)

(A) Referring to claim 4, Besette does not disclose wherein delivering at least one of said formatted medical records to the mobile terminal possessed by the medical provider comprises delivering at least one of said medical records to a personal digital assistant.

Dahlin discloses the use of a personal digital assistant (para. 11 of Dahlin; the Examiner interprets "Palm V computer" to be a form of "personal digital assistant").

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Dahlin within Besette. The motivation for doing so would have been to allow medical practitioners to utilize EMR systems while working with patients (para. 11 of Dahlin).

(B) Referring to claim 6, Besette does not disclose wherein extracting pre-existing medical records from a database comprises extracting pre-existing medical records from a proprietary database.

Dahlin discloses a proprietary database (para. 139 of Dahlin; the Examiner interprets "database software such as Oracle 7" to be form of "proprietary database").

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Dahlin within Besette. The motivation for doing so would have been to have the ability to manage various databases (para. 139, lines 8-11 of Dahlin).

8. Claims 10-14 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Besette (US 2001/0016822 A1) in view of Chesanow ("PDAs for Doctors: Your ticket to fast, flawless prescribing").

(A) Referring to claim 10, Besette does not disclose wherein providing each of a plurality of medical providers with a mobile terminal comprises initially giving at least one medical provider a mobile terminal free of charge.

Chesanow discloses wherein providing each of a plurality of medical providers with a mobile terminal comprises initially giving at least one medical provider a mobile terminal free of charge (page 7, para. 4 of Chesanow; the Examiner interprets "palm-size PDA" to be a form of "mobile terminal").

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Chesanow within Besette. The motivation for doing so would have been to encourage physicians to subscribe to the service (page 7, para. 4 of Chesanow).

(B) Referring to claim 11, Besette does not disclose wherein providing each of a plurality of medical providers with a mobile terminal comprises subsequently selling mobile terminals to medical providers.

Chesanow discloses wherein providing each of a plurality of medical providers with a mobile terminal comprises subsequently selling mobile terminals to medical providers (page 7, para. 4 of Chesanow; the Examiner interprets "choose a Palm Vx for \$100" to be a form of "selling mobile terminals").

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Chesanow within Besette. The motivation for doing so would have been for the hardware cost to be the responsibility of the customer (page 7, para. 4 of Chesanow).

(C) Referring to claims 12-14, Besette does not disclose further comprising charging a fee for access to said information, wherein charging a fee for access to said information comprises charging a monthly fee for access to said information, and wherein charging a fee for access to said information comprises charging an annual fee for access to said information.

Chesanow discloses charging fees for access to said information (page 7, para. 4 of Chesanow; the Examiner interprets "\$20 a month" to be a form of "monthly fee" and "subscribe...for a year" to be a form of "annual fee").

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Chesanow within Besette. The motivation for doing so would have been to compensate the provider for services rendered.

(D) Referring to claim 20, Besette does not disclose further comprising a charge capture service to maintain a list of costs corresponding to services administered to a patient.

Chesanow discloses further comprising a charge capture service to maintain a list of costs corresponding to services administered to a patient (page 7, para. 6 of Chesanow; the Examiner interprets "capture patient billing data" to be a form of "charge capture service").

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Chesanow within Besette. The motivation for doing so would have been to allow the user to view a record of the patient's billing information (page 7, para. 6 of Chesanow).

9. Claims 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Besette (US 2001/0016822 A1) in view of Kilgore et al. (US 2002/0072911 A1).

(A) Referring to claim 28, Besette does not disclose wherein the main database comprises a census of each patient within the medical facility and an expected discharge time.

Kilgore discloses wherein the main database comprises a census of each patient within the medical facility and an expected discharge time (para. 5 of Kilgore; the Examiner interprets "various types of information related to each patient" to be a form of "census").

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Kilgore within Besette. The motivation for doing so would have been to provide hospital management with information to make

management decisions that maintain or improve the quality of the health care (para. 5, lines 1-6 of Kilgore).

(B) Referring to claim 29, Besette does not disclose further including changing the expected discharge time for a patient based on updated information from the doctor.

Kilgore discloses further including changing the expected discharge time for a patient based on updated information from the doctor (para. 42, para. 98, and Fig. 13, item 242 of Kilgore).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Kilgore within Besette. The motivation for doing so would have been to track patients and information related to the patients (para. 7, lines 1-2 of Kilgore).

10. Claims 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Besette (US 2001/0016822 A1) in view of Felsher (US 2002/0010679 A1).

(A) Referring to claim 33, Besette does not disclose wherein each of said patient's medical status comprises an expected departure date, the step of updating the database to include treatment updates comprises altering the expected departure date.

Felsher discloses wherein each of said patient's medical status comprises an expected departure date, the step of updating the database to include treatment updates comprises altering the expected departure date (para. 56 and para. 65 of Felsher; the Examiner interprets "discharge" to be a form of "departure" and "service" to be a form of "treatment").

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Felsher within Besette. The motivation for doing so would have been to keep a record of findings from discharge summaries (para. 10 of Felsher).

(B) Referring to claim 34, Besette does not disclose wherein each medical status comprises a bill containing each service indicated in the treatment updates.

Felsher discloses wherein each medical status comprises a bill containing each service indicated in the treatment updates (para. 65 of Felsher).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Felsher within Besette. The motivation for doing so would have been to keep track of all services provided to the same patient (para. 65, lines 16-24 of Felsher).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied prior art teaches a palm reader ("Palm Reader"); a patient information manager for the palm connected organizer ("Mobile MedData Is The Leading Patient Information Manager for the Palm Connected Organizer"); and high tech tools that make the physician's life easier ("Nifty high tech tools make the physician's life easier").

Also included are provisional applications 60/216,199 and 60/223,246, which are priority documents to applied reference, US 2002/0010679 A1 (Felsher). Provisional


Art Unit: 3626


application 60/252,872 is a priority document to applied reference, US 2004/0078215 A1 (Dahlin et al.).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lena Najarian whose telephone number is (703) 305-0260. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


ln
2-18-05


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600